



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/871,415	05/30/2001	Stephen G. Perlman	50588/356	9275

32641 7590 08/17/2006

DIGEO, INC C/O STOEL RIVES LLP
201 SOUTH MAIN STREET, SUITE 1100
ONE UTAH CENTER
SALT LAKE CITY, UT 84111

EXAMINER

MOORTHY, ARAVIND K

ART UNIT PAPER NUMBER

2131

DATE MAILED: 08/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/871,415

Applicant(s)

PERLMAN, STEPHEN G.

Examiner

Aravind K. Moorthy

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-29, 31-41, 43-45, 56 and 57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-29, 31-41, 43-45, 56 and 57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This is in response to the communication on 13 June 2006.
2. Claims 23-29, 31-41, 43-45, 56 and 57 are pending in the application.
3. Claims 23-29, 31-41, 43-45, 56 and 57 have been rejected.
4. Claims 1-22, 30, 42 and 46-55 have been cancelled.

Response to Arguments

5. Applicant's arguments with respect to claims 23-29, 31-41, 43-45, 56 and 57 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. **Claims 29 and 31-40 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Claims 29 and 31-40 are directed towards a machine-readable medium having program code stored thereon which, when executed by a processor, are caused to perform a set of operations. The examiner refers the applicant to the specification (page 43, lines 16 and 19). The applicant claims the machine-readable medium as propagation media. When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored in a computer-readable medium, in a computer, on an electromagnetic carrier signal does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting

Art Unit: 2131

that the claims for an algorithm in Benson were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer."). Such a result would exalt form over substance. In re Sarkar, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978)

("[E]ach invention must be evaluated as claimed; yet semantogenic considerations preclude a determination based solely on words appearing in the claims. In the final analysis under Sec. 101, the claimed invention, as a whole, must be evaluated for what it is.") (quoted with approval in Abele, 684 F.2d at 907, 214 USPQ at 687).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 23-29, 31, 32, 36-41, 43, 44, 56 and 57 are rejected under 35 U.S.C. 102(e) as being anticipated by Caronni et al U.S. Patent No. 6,195,751 B1.

As to claim 23, Caronni et al discloses a method for deploying new multimedia receiver apparatuses comprising:

encrypting channels using both conditional access ("CA") encryption and
a different form of encryption [column 7 line 46 to column 8 line 20]; and
simulcasting the channels encrypted in both CA encryption and the
different form of encryption [column 7 line 46 to column 8 line 20];

the channels encrypted using the different form of encryption being decryptable by the new multimedia receiver apparatuses and the channels encrypted using the CA encryption being decryptable by other multimedia receiver apparatuses [column 7 line 46 to column 8 line 20].

As to claim 24, Caronni et al discloses that the method further comprises:

transmitting a specified group of channels using no encryption [column 12, lines 26-39].

As to claim 25, Caronni et al discloses that the specified group of channels are basic cable channels and the channels being simulcast are premium channels [column 6, lines 44-56].

As to claim 26, Caronni et al discloses that the method further comprises:

encrypting a portion of the specified group of channels using both CA encryption and a different form of encryption [column 16 line 64 to column 17 line 33]; and

simulcasting the portion encrypted using CA encryption and the portion encrypted using the different form of encryption [column 16 line 64 to column 17 line 33].

As to claim 27, Caronni et al discloses that the different form of encryption is digital video broadcast (“DVB”) encryption [column 16 line 64 to column 17 line 33].

As to claim 28, Caronni et al discloses that the method further comprises:

regularly modifying channels included within the portion [column 16 line 64 to column 17 line 33].

As to claims 29 and 56, Caronni et al discloses a computer-implemented method for processing multimedia channels comprising:

encrypting a first group of multimedia channels using conditional access ("CA") encryption to produce a first group of encrypted multimedia channels [column 7 line 46 to column 8 line 20],

encrypting the first group of multimedia channels using a different type of encryption to produce a second group of encrypted multimedia channels [column 7 line 46 to column 8 line 20],

simulcasting the first group of encrypted multimedia channels with the second group of encrypted multimedia channels to a plurality of multimedia subscribers having either a new multimedia receiver or a legacy multimedia receiver, the second group of encrypted multimedia channels being decryptable by the new multimedia receivers and the first group of encrypted multimedia channels being decryptable by the legacy multimedia receivers [column 7 line 46 to column 8 line 20].

As to claims 18 and 42, Caronni et al discloses that the first type of encryption is standard conditional access ("CA") encryption [column 7 line 46 to column 8 line 20].

As to claims 31 and 43, Caronni et al discloses that the different type of encryption is digital video broadcast ("DVB") encryption [column 7 line 46 to column 8 line 20].

As to claim 32, Caronni et al discloses that the first group of multimedia channels are subscription based channels [column 7 line 46 to column 8 line 20].

As to claim 36, Caronni et al discloses that the method further comprises:

transmitting a second group of multimedia channels in an unencrypted format [column 15, lines 55-63].

As to claim 37, Caronni et al discloses that the second group of multimedia channels are basic cable channels and the first group of multimedia channels are subscription-based cable channels [column 7 line 46 to column 8 line 20].

As to claim 38, Caronni et al discloses that the method further comprises:

encrypting a first subset of the basic cable channels using the first type of encryption to produce a first group of encrypted basic cable channels [column 7 line 46 to column 8 line 20];

encrypting the first subset of the basic cable channels using the different type of encryption to produce a second group of encrypted basic cable channels [column 7 line 46 to column 8 line 20]; and

concurrently transmitting the first group of encrypted basic cable channels with the second group of encrypted basic cable channels to the plurality of multimedia subscribers [column 7 line 46 to column 8 line 20].

As to claim 39, Caronni et al discloses that the method further comprises:

transmitting a second subset of the basic cable channels in an unencrypted format [column 15, lines 55-63].

As to claim 40, Caronni et al discloses that the method further comprises:

regularly transferring channels from the first subset of basic cable channels to the second subset of basic cable channels and channels from the second subset of basic cable to the first subset of basic cable channels [column 10, lines 28-48].

As to claim 41, Caronni et al discloses a headend system for processing multimedia streams comprising:

a first encryption module to encrypt a first plurality of multimedia streams using conditional access ("CA") encryption [column 7 line 46 to column 8 line 20]; and

a second encryption module to encrypt the first plurality of multimedia streams using a different type of encryption [column 7 line 46 to column 8 line 20]; and

a quadrature amplitude modulation module to modulate the first plurality of multimedia streams encrypted in both CA encryption and the different type of encryption for transmission to a plurality of multimedia subscribers having either a new multimedia receiver or a legacy multimedia receiver, each new multimedia receiver being capable of decrypting the first plurality of multimedia channels encrypted in the different type of encryption and each legacy multimedia receiver being capable of decrypting the first plurality of multimedia channels encrypted in the CA encryption [column 7 line 46 to column 8 line 20].

As to claim 44, Caronni et al discloses that the first plurality of multimedia streams are premium cable channels [column 7 line 46 to column 8 line 20].

As to claim 57, Caronni et al discloses a system comprising:

means for encrypting channels using both conditional access ("CA") encryption and a different form of encryption [column 7 line 46 to column 8 line 20]; and

means for simulcasting the channels encrypted in both CA encryption and the different form of encryption to subscribers having either a new multimedia receiver or a legacy multimedia receiver, the channels encrypted using the different form of encryption being decryptable by the new multimedia receivers and the channels encrypted using the CA encryption being decryptable by the legacy multimedia receivers [column 7 line 46 to column 8 line 20].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caronni et al U.S. Patent No. 6,195,751 B1 as applied to claims 1, 13 and 29 above, and further in view of Traw et al U.S. Patent No. 6,542,610 B2.

As to claims 5-7, 20-22 and 33-35, Caronni et al does not teach that the method further comprises compressing the first group of encrypted multimedia channels using a first

compression type and the second group of encrypted multimedia channels using a second compression type. Caronni et al does not teach that the first compression type is MPEG-2. Caronni et al does not teach that the second compression type is MPEG-4. Caronni et al does not teach a first decompression module to decompress one or more of the first plurality of multimedia streams previously compressed by content providers using the first compression type and to transmit the one or more multimedia streams to the second compression module for re-compression using the second compression type.

Traw et al teaches compressing a first group of encrypted multimedia channels using a first compression type and the second group of encrypted multimedia channels using a second compression type. Traw et al teaches that the first compression type is MPEG-2. Traw et al teaches that the second compression type is MPEG-4. Traw et al teaches a first decompression module to decompress one or more of the first plurality of multimedia streams previously compressed by content providers using the first compression type and to transmit the one or more multimedia streams to the second compression module for re-compression using the second compression type [column 4, lines 3-65].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Caronni et al so that the method further comprised compressing the first group of encrypted multimedia channels using a first compression type and the second group of encrypted multimedia channels using a second compression type. The first compression type would have been MPEG-2. The second compression type would have been MPEG-4. There would have been a first decompression module to decompress one or more of the first plurality of multimedia streams previously compressed by content providers using the

Art Unit: 2131

first compression type and to transmit the one or more multimedia streams to the second compression module for re-compression using the second compression type.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Caronni et al by the teaching of Traw et al because using compression types of MPEG-2 and MPEG-4 provides good broadcast quality and provides low bandwidth video [column 4, lines 3-7].

9. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Caronni et al U.S. Patent No. 6,195,751 B1 as applied to claim 41 above, and further in view of Traw et al U.S. Patent No. 6,542,610 B2.

As to claim 45, Caronni et al does not teach that the method further comprises compressing the first group of encrypted multimedia channels using a first compression type and the second group of encrypted multimedia channels using a second compression type. Caronni et al does not teach that the first compression type is MPEG-2. Caronni et al does not teach that the second compression type is MPEG-4. Caronni et al does not teach a first decompression module to decompress one or more of the first plurality of multimedia streams previously compressed by content providers using the first compression type and to transmit the one or more multimedia streams to the second compression module for re-compression using the second compression type.

Traw et al teaches compressing a first group of encrypted multimedia channels using a first compression type and the second group of encrypted multimedia channels using a second compression type. Traw et al teaches that the first compression type is MPEG-2. Traw et al teaches that the second compression type is MPEG-4. Traw et al teaches a first decompression

Art Unit: 2131

module to decompress one or more of the first plurality of multimedia streams previously compressed by content providers using the first compression type and to transmit the one or more multimedia streams to the second compression module for re-compression using the second compression type [column 4, lines 3-65].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Caronni et al so that the method further comprised compressing the first group of encrypted multimedia channels using a first compression type and the second group of encrypted multimedia channels using a second compression type. The first compression type would have been MPEG-2. The second compression type would have been MPEG-4. There would have been a first decompression module to decompress one or more of the first plurality of multimedia streams previously compressed by content providers using the first compression type and to transmit the one or more multimedia streams to the second compression module for re-compression using the second compression type.


It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Caronni et al by the teaching of Traw et al because using compression types of MPEG-2 and MPEG-4 provides good broadcast quality and provides low bandwidth video [column 4, lines 3-7].

Conclusion


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aravind K. Moorthy whose telephone number is 571-272-3793. The examiner can normally be reached on Monday-Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Aravind K Moorthy 
August 14, 2006

CHRISTOPHER REVAK
PRIMARY EXAMINER

 8/16/06